

Remarks

The above Amendments and these Remarks are in reply to the Office action mailed January 31, 2003. With the cancellation of Claim 21 and the addition of Claims 23 and 24, Claims 3-20 and 22-24 are presented herewith for consideration.

Applicant notes with appreciation the telephonic interview held on June 19, 2003 with the undersigned attorney.

Rejection of Claims 3-22 Under 35 U.S.C. §112

Claims 3-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejection as follows.

A. Summary of The Invention

Dolls and like figures are well known where the arms, legs and other body parts may be detached. However, applicant realized that each of these toys, while entertaining, was severely limiting on a child's imagination. In particular, the inventor of the present invention saw the opportunity for children to greatly enhance their play experience by providing the opportunity for the child to create new, unknown, even nonsensical characters and objects by snapping together random and unrelated parts, appendages and pieces.

Thus, as shown for example in the first figure on the attached Sheet 2, a character could be created having a camel's head, a pig's torso, chicken's feet and an alligator's tail. The remaining

two figures on Sheet 2 show further alternative possibilities. There are obviously a very large number other combinations and possibilities.

The inventor further realized that the child's play experience would be enhanced even more by providing the ability to create even more absurd and irrational objects, for example, to name a few:

- an airplane having an animal or human head on its front,
- an automobile with an dinosaur's tail in place of the rear of the car,
- an alphabet block with an arm attached to it,
- a helicopter with a plant in place of the rotor,
- wire endoskeleton arms, legs, etc. affixed to a plush torso.

The above example sets forth merely a few examples. There are many, many more combinations of parts that are possible under the present invention to create a wide variety of new and unusual categories of characters. Some additional embodiments are shown on attached Sheets 3 through 6.

The inventor also further realized the potential benefits of providing the ability to attach pieces of different scales and sizes. Thus, for example, in accordance with the present invention, a large body could have a tiny head attached to it.

The more ridiculous and absurd, the more fun it would be for a child. Moreover, child psychologists uniformly acknowledge the benefits of toys which foster imagination and creativity, especially those that provide children with the cognitive ability to think outside of conventional boundaries.

In order to provide these benefits, the inventor conceived of a system where every piece of the system could be attached to every other piece of the system. Thus, body parts on one type of

character could be used with other types of characters to form totally unique, distinct and different catagories. Objects forming part of animals or humans could be used with objects forming part of a truck, as shown on attached Sheet 3. Large parts could fit together with small parts. Many torso could be affixed together, or legs could be attached directly to a head, as shown on attached Sheet 4. Again, the combinations are almost limitless and are bounded only by the child's imagination.

The ability to provide this universal connectivity of any one part to any other part was an extremely difficult problem to solve. One method the inventor conceived of was to provide a universal snap so that a single snap portion on one part could mate with different size snap portions on other parts.

B. The Specific Indefiniteness Rejections

Against this backdrop, the claims are more easily seen to be clear and definite.

With respect to the first indefiniteness rejection, applicants have corrected the informality so that the phrase in question has been amended from "one of one or more legs," to "one or more legs."

With regard to the second indefiniteness rejection, the Examiner stated that:

it is unclear as to what is the relationship between the recited elements of the Markush grouping. For example only, it is unclear how the automobile relates to the one or more torsos or the one or more arms. In yet another example, it is unclear how one or more portions of an airplane relates to one or more portions of a train.

Hopefully this issue has been clarified by the description of the invention above. It is precisely a feature of the present invention that completely unrelated objects can be mated together to form unusual and even ridiculous new objects. While an object thus formed may not make sense,

that is unrelated to whether a claim reciting the object is clear. Claim 3 recites the invention in a manner that is clear and definite.

The test for definiteness under §112, second paragraph is whether:

one skilled in the art would understand the bounds of the claim when read in light of the specification. . . . If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more. . . . The degree of precision necessary for adequate claims is a function of the nature of the subject matter.

Miles Laboratories, Inc. v. Shandon Inc., 997 F.2d 870 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). Under this standard, one skilled in the art, upon reading the specification, would clearly understand the meaning of Claim 3 and the bounds set forth by the claim. No more is required.

With regard to the next indefiniteness rejection, the Examiner stated that Claim 3 was indefinite because of the recitation of “one or more blocks including characters and/or letters.” In support, the Examiner stated that broad language in a claim followed by “such as” and then narrow language has been held by the Board of Patent Appeals and Interferences to be indefinite. Applicant respectfully submits that the rule of law relied upon by the Examiner is inapplicable to the language in question in Claim 3. Applicant respectfully points out that Claim 3 nowhere recites the phrase “such as,” or anything having the effect of that phrase. It is in fact unclear to applicant where the Examiner finds any ranges, let alone broad and narrow ranges, in the phrase “one or more blocks including characters and/or letters.” Characters and/or letters are not the same as, nor a narrower range of, blocks. There is therefore no problem with this language under the rule of law cited by the Examiner or section 112, second paragraph in general. Applicant respectfully submits that one of skill in the art would clearly understand this phrase not to recite broad and narrow ranges of any

kind, and would understand the phrase to be clear and definite.

Regarding the next indefiniteness rejection, relating to Claim 8, the Examiner stated that:

it is unclear to the examiner the relationship between the claim elements of the Markush grouping. For example only, it is unclear as to how the mustache is related to the one or more animal trunks

As explained above, it is a feature of the present invention that any two parts may fit together to form new, unusual and even absurd objects. It is precisely the seeming unrelatedness of two objects that make them ideal under the present invention to be attached to each other. The Examiner's own example of a mustache attaching to an animal trunk is a perfect example of a new and imaginative creation possible in accordance with the present invention. It is respectfully submitted that the recitation of Claim 8 is clear and definite.

The Examiner further indicated that it was "unclear if 'snap portion' of line 15 is the same as one of the snap portions of claim 3." Applicant has clarified in Claim 8 that it is.

With regard to Claim 9, the Examiner indicated it was unclear whether the claim was directed to a toy and toy classes or a toy alone. Applicant confirms that the Examiner's assumption is correct that the claim is directed to a toy.

The Examiner further indicated that Claim 9 was unclear because of the use of the terms "known" and "unknown." In particular, the Examiner argues that it would be unclear what is known and what is unknown. Applicant has deleted those phrases from Claim 9. However, applicant has not deleted those phrases from Claim 9 for the purposes of patentability, but rather to broaden Claim 9. As support, applicant has left the term "known" in the claims after Claim 9. It is respectfully submitted that one of skill in the art would understand the terms "known" and "unknown" upon reading the specification and would clearly understand the bounds of the claims. In particular, the

term "unknown" as used by applicant refers to pieces from different toy classes that are combined to form made up and even absurd characters and objects. Some of these are shown in the attached figures and include a character having a camel's head, a pig's torso, chicken's feet and an alligator's tail, or an airplane having an animal or human head on its front. The term "known" as used by the applicants refers to recognizable figures, such as a figure resembling a human, animal, or automobile.

A claim, when read in light of the specification, need only "reasonably apprise" one of skill in the art of the bounds of a claim. *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). Applicant respectfully submits that the claim terms "known" and "unknown" would be clearly understood by one of skill in the art to have above meanings when read in light of the specification under this standard.

The Examiner next indicated that the use of the term "may comprise" was indefinite in the claims. The claims have been amended to remove this informality.

Finally, the Examiner indicated that Claim 21 was vague because the following phrase was indefinite:

universal snap portions ...including one of a first snap portion having a first size, a second snap portion have a second size, and a third snap portion have a third size different than said second size.

In support, the Examiner stated that broad language in a claim followed by "such as" and then narrow language has been held by the Board of Patent Appeals and Interferences to be indefinite. Claim 21 has been canceled. However, applicant respectfully traverses the rejection. Once again, as in Claim 3 above, applicant respectfully submits that the rule of law relied upon by the Examiner is inapplicable to the above-quoted phrase. Claim 21 nowhere recites the phrase "such as," or anything

having the effect of that phrase. Nor is the above phrase at all related to broad ranges and narrow ranges. The phrase recites elements (the universal snap portions), and provides structural limitations of the universal snap portions (first, second and third snap portions of different sizes). There is no problem with this language under the rule of law cited by the Examiner or section 112, second paragraph in general. Applicant respectfully submits that one of skill in the art would clearly understand this phrase not to recite broad and narrow ranges of any kind, and would understand the phrase to be clear and definite.

Based on the above, it is respectfully requested that each of the above rejections of the claims on section 112, second paragraph grounds be withdrawn.

Rejection of Claims 3 and 8-18 Under 35 U.S.C. §102(b)

Turning now to the prior art rejections, Claims 3 and 8-18 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,506,328 to *Alger* ("*Alger*"). Applicant respectfully traverses the rejection as follows.

Alger discloses a toy human figure where portions of the figure are removable. *Alger* does not disclose, teach or in any way suggest the feature of parts from a wide variety of different people, animals, plants and objects, each of which parts may be connected to any other part, as expressly called for in Claim 3 and 8-18.

Moreover, Claims 9-18 as amended recite the feature of male and female snap portions of different sizes, each male portion being capable of mating with each female portion. This feature is not disclosed, taught or suggested in *Alger*.

For a reference to anticipate a patent claim, each and every limitation recited in the claim must be disclosed entirely within the reference. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983). As the cited reference fails to disclose the above-discussed features, that reference cannot anticipate the invention recited in Claims 3 and 8-18. It is therefore respectfully requested that the rejection of Claims 3 and 8-18 on the stated grounds be withdrawn.

Rejection of Claims 21 and 22 Under 35 U.S.C. §102(b)

Claims 21 and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,365,198 to Hay (“*Hay*”).¹ Applicant has canceled Claim 21, but nevertheless respectfully traverses the rejection as follows.

Claim 21, and Claim 22 dependent thereon, each recited first, second and third snap portions of different sizes, and that the different sized snap portions are capable of mating with each other. This feature is nowhere disclosed, taught or in any way suggested in *Hay*.

Based on the above, it is respectfully requested that the rejection of Claims 21 and 22 on the stated grounds be withdrawn.

Rejection of Claims 4 and 19 Under 35 U.S.C. §103(a)

Claims 4 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Alger* in

¹ In the body of the rejection of Claims 21 and 22, the Examiner references Claim 20. It is assumed this is a typographical error and reference to Claim 21 was intended.

view of U.S. Patent No. 5,807,1525 to Divvleeon (“*Divvleeon*”). Applicant respectfully traverses the rejection as follows.

Claims 4 and 19 depend on Claims 3 and 9, respectively. As stated above, Claims 3 and 9 recite features that are nowhere taught or suggested in *Alger*. Namely, Claims 3 and 9 recite parts from a wide variety of different people, animals, plants and objects, each of which parts may be connected to any other part. Moreover, Claim 9 as amended recites the feature of male and female snap portions of different sizes, each male portion being capable of mating with each female portion.

Divvleeon adds nothing to the teaching of *Alger* in this regard.

As the cited references, taken either alone or in combination with each other, fail to teach or suggest the invention recited in Claims 4 and 19, it is respectfully requested that the rejection of these Claims on section 103 grounds be withdrawn.

Rejection of Claims 5 and 20 Under 35 U.S.C. §103(a)

Claims 5 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Alger* in view of U.S. Patent No. 3,419,993 to Rodgers (“*Rodgers*”). Applicant respectfully traverses the rejection as follows.

Claims 5 and 20 depend on Claims 3 and 9, respectively. As stated above, Claims 3 and 9 recite features that are nowhere taught or suggested in *Alger*. Namely, Claims 3 and 9 recite parts from a wide variety of different people, animals, plants and objects, each of which parts may be connected to any other part. Moreover, Claim 9 as amended recites the feature of male and female snap portions of different sizes, each male portion being capable of mating with each female portion.

Rodgers adds nothing to the teaching of *Alger* in this regard.

As the cited references, taken either alone or in combination with each other, fail to teach or suggest the invention recited in Claims 5 and 20, it is respectfully requested that the rejection of these Claims on section 103 grounds be withdrawn.

Rejection of Claims 6 and 7 Under 35 U.S.C. §103(a)

Claims 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Alger* in view of U.S. Patent No. 1,566,801 to Millard (“*Millard*”). Applicant respectfully traverses the rejection as follows.

Claims 6 and 7 depend on Claim 3. As stated above, Claim 3 recites features that are nowhere taught or suggested in *Alger*. Namely, Claim 3 recites parts from a wide variety of different people, animals, plants and objects, each of which parts may be connected to any other part. *Millard* adds nothing to the teaching of *Alger* in this regard.

As the cited references, taken either alone or in combination with each other, fail to teach or suggest the invention recited in Claims 6 and 7, it is respectfully requested that the rejection of these Claims on section 103 grounds be withdrawn.

Based on the above amendments and these remarks, reconsideration of Claims 3-20 and 22, and consideration of Claims 23 and 24, is respectfully requested.

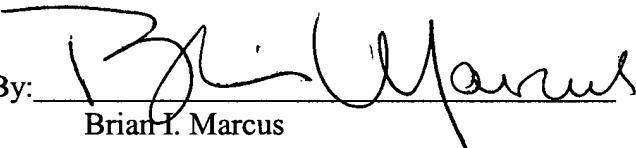
The Examiner’s prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, July 22, 2003.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: July 22, 2003

By: 
Brian I. Marcus
Reg. No. 34,511

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 Market Street, Suite 540
San Francisco, CA 94105-4206
Telephone: 415-369-9660
Facsimile: 415-369-9665